

REMARKS/ARGUMENTS

Applicant thanks Examiner for the detailed Office Action of March 20, 2006. The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Specification

Page 1 of the specification is amended to correct typographical errors in the Co-Pending Applications information. The Applicant submits that no new matter is introduced.

The Examiner has objected that the amendment filed 24 January 2005 as it introduces new matter into the disclosure. The Applicant respectfully disagrees. This issue is dealt with under the next section of the Applicant's response.

Claim Rejections – 35 USC § 112

In the Final Office Action mailed January 27 2006, the Examiner rejected claims 25-54 as failing to comply with the written description requirement. The Examiner has stated that the term "reference points" has not been defined in the specification.

In the Advisory Action the Examiner continues to maintain this rejection.

The Applicant highlights lines 10 to 20 of page 9 which state:

"In brief summary, the preferred form of the netpage system employs a computer interface in the form of a mapped surface, that is, a physical surface which contains references to a map of the surface maintained in a computer system. The map references can be queried by an appropriate sensing device. Depending upon the specific implementation, the map references may be encoded visibly or invisibly, and defined in such a way that a local query on the mapped surface yields an unambiguous map reference both within the map and among different maps."

The Applicant also highlights lines 4 to 5 of page 16 which state:

"When printed at 1600 dots per inch this yields a tag with a diameter of about 4 mm."

It is clear from the specification that a specific implementation of a reference is a tag. It is also clear that a reference is so small that it resembles a point.

The Examiner has stated "[i]f the applicant wants to claim tags, he is urged to do so." With all respect to the Examiner, the Applicant should not have to restrict to the specific embodiment of a tag when it is apparent from the highlighted sections of the specification that a clear disclosure of a broader embodiment has been provided by the Applicant.

We also note MPEP 608.01(o) which states that the "*Applicant is not limited to the nomenclature used in the application filed*". The specification clearly provides support for the term "*reference points*", particularly in view of the highlighted sections above and Figure 1 of the specification. The Applicant notes that drawings provide additional support for the term "*reference points*".

The Applicant also strongly highlights the decision of *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971) which concluded that a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

In the Final Office Action mailed January 27 2006, the Examiner raised claim rejections regarding the term "on/of". The Applicant has amended the claim to specify simply "of" as the Examiner has interpreted the two parts of the phrase to have an equivalent meaning.

In the Final Office Action mailed January 27 2006, the Examiner raised claim rejections regarding the term "substantially". Although the term "substantially" is a relative term, the MPEP states at 2173.05(b) "*[T]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.*"

Furthermore, MPEP 2172.05(b) states:

"The term 'substantially' is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. In re

Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. In *re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" **was definite because one of ordinary skill in the art would know what was meant by "substantially equal."** *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988). (emphasis added)

To simply reject a claim due to a relative term and state that this term is indefinite without giving any consideration to the context which the relative term is provided in the claim and to ignore what is taught in the specification is in total contrast to what the MPEP states, and the Applicant respectfully draws the Examiner's close attention to these relevant sections of the MPEP and US case law noted above.

The specification refers to invisible coded data with reference to the example of the infrared spectrum. The boundaries of the infrared spectrum and the visible spectrum are not precise or exact. Therefore, the term "substantially" is used to reflect this relativeness of what is considered invisible in terms of the specification. As the specification includes such examples referring to the coded data being printed with "infrared-absorptive ink" (see page 13 of the specification), the Applicant respectfully submits that it would be considered definite to a skilled person in the art what is meant by "*substantially invisible in the visible spectrum*". A person skilled in the art would understand the scope and boundaries of the claim in regard to range of the visible spectrum and the purpose which this serves in the context of the specification, which is to ensure that the user can see the visible information on the page yet be unable to see the coded data printed on the page so as to not detract from the visible presentation of the page and to more usefully utilise the area provided by the page.

Reconsideration and withdrawal of the claim rejection is respectfully requested.

Claim Rejections – 35 USC § 102

In the Final Office Action mailed January 27 2006, the Examiner rejected claims 25-28, 34-36, 38, 39, 42-44, and 48-50 as being anticipated by Izawa et al. (US Patent Number 5,420,406).

Furthermore, the Examiner has stated in the Advisory Action that "[w]ith regard to applicant's argument that Izawa does not disclose identifying the position of the barcode on the page, the examiner points out that this is not what the applicant claimed. Applicant claims, "position of the sensing device relative to at least one of the reference points". Izawa identifies the position of the sensing device (passage) relative to a reference point (the document).

However, the Applicant respectfully submits that the Examiner has overlooked a number of factors which distinguish the currently rejected claims from Izawa et al.

In particular, Izawa et al states at column 3, lines 27 to 29 that "*A motor encoder is provided to generate pulses in order to detect exact position of the document within the passage*".

Thus, Izawa et al discloses that it is not any one of the sensors that is used to determine the position of the document in the passage. Izawa et al explicitly teaches that a motor encoder detects the exact position of the document within the passage.

Furthermore, at column 5, lines 11 to 16, Izawa et al states "*The motor encoder electromagnetically or photoelectrically produces electric pulses in response to rotated angles of the motor so that the CPU 40 exactly detects the position of the inserted bill by counting pulses from the motor encoder 39 regardless of rotating rate of the motor*". Again, Izawa et al teaches that the motor encoder is used to determine the exact position of the document in the passage using a counting method of electric pulses.

Additionally, at column 5, lines 32 to 38, Izawa et al states "*Ferrous ink and bar code are printed in predetermined positions of bills or coupons so that positions of ferrous ink and bar code are easily detected by counting pulses generated by the motor encoder 38 as the number of counted pulses indicates exact position of the bill or document in the passageway*". So again, Izawa et al explicitly describes that the position of the document is determined by the motor encoder.

Claim 1 states:

receiving data from a sensing device, the data including the identity and a position of the sensing device relative to at least one of the reference points, the data having been generated by the sensing device sensing at least some of the coded data;
(emphasis added)

Izawa et al does not show that the motor encoder senses at least some of the coded data. Izawa et al clearly shows that the motor encoder counts electric pulses which are used to determine the position of the document in the passage. Izawa et al clearly cannot be considered to anticipate claim 1 because the motor encoder 38 of Izawa et al does not sense coded data to generate the data indicative of the position of the sensing device relative to the reference point.

The MPEP states at 2131 that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >

Iwaza et al fails to disclose the element of *"receiving data from a sensing device, the data including the identity and a position of the sensing device relative to at least one of the reference points, the data having been generated by the sensing device sensing at least some of the coded data"*.

As each and every element as set forth in the claim has not be found, either expressly or inherently described, in a single prior art reference, the Applicant respectfully submits that the claim is not anticipated by Iwaza et al.

The above arguments also apply to the remaining independent claims.

Reconsideration and withdrawal of the claim rejection is respectfully requested.

The Examiner has rejected claims 29, 30-33, 37, 40, 41, 45-47, and 51-54 as being unpatentable over Wang et al (US Patent Number 5,710,419) in view of Izawa.

The Examiner has stated in the Advisory Action *"With regard to applicant's argument that Wang can not [sic] be used since an erasable bar code could not be used to verify or authenticate a document, the examiner disagrees. A human being can be identified with both a driver's licence and a retina scan. Even though a driver's licence is disposable, and not tied to the person, it is useable for authentication. A bar code need not be permanent to be used to verify and authenticate."*

Clearly the analogy provided above by the Examiner is in relation to authenticating a human being, not a document. The claims are related to authenticating a verifying a document, not a human being. With all respect to the Examiner, the Applicant respectfully requests that the Examiner avoid digressing from the subject matter of the claims.

The Applicant highlight's the inappropriateness of erasable ink for authenticating and verifying a document with the following example. If a licence is to be authenticated and it was printed with erasable ink, the owner of the licence could erase a part of they're name to obtain a totally new identity. For example, the licence is printed with the name of "JOHN DOH" could easily be modified to indicate "JOHN DO".

Clearly it is totally inappropriate to print a document, such as a licence, with an erasable ink because any security associated with the authentication is jeopardized. Claim 1 states "*A method of verifying the validity status and/or authenticity information of a secure document*". It is totally illogical to print coded using erasable ink on a secure document when the application of the coded data is for use in authenticating the secure document which it is printed thereon. The use of erasable ink on a document actually makes the document insecure.

Again, the Applicant highlights MPEP 2141.01(a)(I) which states that:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent

to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); (emphasis added)

Wang et al relates to a printing and reading system which prints bar codes using erasable ink. The current application relates to determining the validity status of a secure document. Thus, it is clearly apparent that Wang et al is not a reference in the field of the applicant's endeavor.

Furthermore, the applicant's problem related to verifying the validity status of a secure document. Wang describes a solution which actually hinders the applicant's problem bar codes could easily be changed based on the teachings of Wang et al, the document is insecure which contrasts to claim 1 which related to a secure document. Wang would not logically have commended itself to an inventor's attention in considering his problem. Therefore, Wang et al is not reasonably pertinent to the particular problem with which the inventor was concerned.

As both questions as stated at MPEP 2141.01(a)(I) should be answered in the negative considering the teachings of Wang et al, the Applicant respectfully submits that Wang et al is not an analogous art as defined by the MPEP.

As Wang et al is not in the field of applicant's endeavor, and is not reasonably pertinent to the particular problem with which the inventor was concerned, Wang et al cannot be relied upon as a basis for an obviousness rejection of the applicant's claims, as per *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Furthermore, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

As the Examiner has relied upon of Izawa *et al.* for disclosing receiving data indicative of a position of the sensing device relative to at least one reference point, which we have noted above is not expressly or inherently described in this reference, the combination of Izawa *et al.* in view of Wang *et al.* would fail to meet the third basic requirement of a prima facie case of obviousness.

In particular, Izawa in view of Wang fails to teach or suggest all the claim limitations including *"receiving data from a sensing device, the data including the identity and a position of the sensing device relative to at least one of the reference points, the data having been generated by the sensing device sensing at least some of the coded data"*.

As all three basic requirements of a prima facie case of obviousness must be met in order to state that a claim is obvious and therefore reject the claim as unpatentable, the Applicant respectfully requests that this claim rejection be withdrawn as all three basic requirement has not been satisfied.

The above arguments also apply to the remaining independent claims.

Reconsideration and withdrawal of this claim rejection is respectfully requested.

Double Patenting

The Examiner has advised the Applicant on page 6 that if claim 25 was to be found allowable, claim 35 would be objected to as being a substantial duplicate thereof. Although the Applicant appreciates the Examiner's note, we respectfully submit that although the claims appear similar, they cover different scope and should not be objected as double patenting.

Claim 25 recites that the method includes the three steps of recording, receiving, and verifying. Claim 35 recites that the method includes the two steps of receiving and verifying.

The recording step may have been performed by a separate entity. This is indicated by the wording *"has been recorded in a computer system"*. As such, the method of claim 35 only requires the two steps to be performed.

MPEP 706.03(k) states:

"Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim."

The Applicant has the right to restate the method in a reasonable number of ways. The Applicant in this case wishes to state that the method specified in claim 25 can be performed by one entity performing the recording, receiving and verifying steps, whereas the method specified in claim 35 can be performed by performing the receiving and verifying steps wherein the recorded step may have been performed earlier and may not necessarily have been performed by the same entity which performs the other two steps. Claim 25 and claim 35 are *"not so close that they cover the same thing"* as claim 25 requires the recording step to be performed in the method whereas claim 35 requires that the recording step has already been performed. Although this is a slight difference, this difference does not amount to conclusion that the claims are *"so close that they cover the same thing"*. The Applicant requests that the Examiner reconsider the potential double patenting rejection based on the above arguments.

Other Voluntary Amendments

The Applicant has also introduced an amendment to claim 43. Support for this feature can be found in claim 25. The Applicant submits that this amendment introduces no new subject matter.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

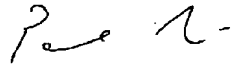
Very respectfully,

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